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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,911	01/15/2002	Juan Pons Bolta	3973-011491	2721

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[REDACTED] EXAMINER

BELL, KENT L

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1661

DATE MAILED: 03/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/047,911	BOLTA
	KENT L. BELL	Art Unit 1661
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>application filed 1/15/02</u> 2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final. 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1</u> is/are pending in the application. 4a) Of the above, claim(s) _____ is/are withdrawn from consideration. 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. 6) <input checked="" type="checkbox"/> Claim(s) <u>1</u> is/are rejected. 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner. 10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>1/15/02</u> is/are a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action. 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). *See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. 15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)      4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____      6) <input type="checkbox"/> Other: _____		

**Detailed Action**

**Status of Application**

A second specification was filed April 22, 2002. This second specification appears to be identical to the originally filed specification and therefor has not been entered. Applicant should specifically cancel the specification filed April 22, 2002 unless that specification is to be used. Applicant should advise the Examiner whether to use or cancel the specification filed April 22, 2002.

**Objection to the Drawing**

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The drawings are objected to under 37 CFR 1.165(a) as the illustrations of record are not competently and/or artistically executed. The drawings are so out of focus, blurry, and dark they convey no useful information. New photographic illustrations which clearly depict the instant cultivar in its entirety and a close-up view of typical fruit should be made of record in this application. Applicant is reminded that it is the entire plant for which plant protection is being sought, as such, applicant needs to provide description (be it in written or photographic form) for all characteristic plant features capable of same. New photographic illustrations of the instant

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cultivar depicting its growth habit, leaves, and fruit, if artistically and competently executed, would show typical characteristics of same. While applicant may not consider these features to be the main patentable differences or distinction, they need to be described and/or illustrated so as to provide as complete a botanical description of the plant as is reasonably possible (37 CFR 1.163(a)). It is suggested that applicant reprint the same photographic illustrations onto photographic type paper either by laser or ink jet printers or other means which would reproduce the images clearly. It is also suggested that applicant provide a photographic illustration depicting the inside of a typical fruit of the instant cultivar.

The drawings should not be sent to the 20231 zip code address for the United States Patent and Trademark Office. Please direct all replies to the United States Patent and Trademark Office via one of the following:

1. Hand carried directly to:  
1911 South Clark Place  
Crystal Mall One, 7th Floor Receptionist Area  
Arlington, Virginia 22202
  
2. Mailed to:  
U.S. Patent and Trademark Office  
P.O. Box 2327  
Arlington, Virginia 22202

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**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the “BACKGROUND OF THE INVENTION” section as set forth in 37 CFR 1.163(c).

B. Page 1, lines 10, 16, 18, and 20, Applicant is requested to set forth in the specification whether the cultivars ‘Citrangle’, ‘Clemenules’, ‘Arrufatina’, ‘Fina’ (Commune) have been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name.

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If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

C. Page 1, lines 6 and 7, Applicant states the instant plant was found as a seedling in Pego Aligante, Spain. However, the origin of the instant plant is uncertain as the Bono et al. article (referenced in the 102(b) rejection below) states ‘Clemenpons’ is a spontaneous mutation of the ‘de Nules’ cultivar (Page 175, Col. 2, lines 23-25). If such is the case, Applicant should set forth in the specification the patent status of the parental cultivar (as set forth in “B” above) and import into the specification a brief comparison between the instant plant and the parental cultivar, such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other. Correction and/or clarification is necessary. The origin of the plant must be clearly and unambiguously set forth.

D. Page 1, line 30, When compared to the photographic illustration provided (Fig. 3), data is set forth which is not explained in the specification nor understood. Applicant should set forth in the specification what “1000.a/L.b (Parametros de Hunter)” and the numbers under the fruit represent/mean. It is also urged that applicant reprint this photographic illustration more clearly and submit it in place of the originally filed illustration so that the data set forth can be read accurately (As set forth in the Objection to the Drawing above).

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E. Page 1, lines 33 and 34, Applicant should specify which rootstock was used for the asexual reproduction.

F. Page 1, line 34 to page 2, line 1, Applicant states the age of the tree when described but does not state where the instant tree was described. Applicant should set forth in the specification the location where the instant plant was described.

G. Page 2, line 7, Applicant states growth rate "Medium vigor". Applicant should quantify this statement by setting forth in the specification the typical and observed amount of time it takes to produce a tree which produces fruit and the typical and observed amount of growth per season.

H. Page 2, lines 7-11, Applicant should set forth in the specification information relative to the instant tree's trunk including the typical and observed trunk diameter at a specified height above the ground, and bark coloration (young and old) with reference to the employed color chart.

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I. Page 2, lines 12-23, Applicant should set forth in the specification additional information relative to the instant tree's venation including the venation pattern and coloration with reference to the employed color chart.

J. Page 2, lines 24-26, Applicant should set forth in the specification additional information relative to the instant tree's petiole including petiole coloration with reference to the employed color chart.

K. Page 2, line 32, Applicant should set forth in the specification additional information relative to the instant tree's sepals including the typical and observed sepal shape, length, width, apex, base, and margin descriptor, and coloration (both surfaces) with reference to the employed color chart.

L. Page 3, lines 1-3, Applicant should set forth in the specification additional information relative to the instant tree's petals including the typical and observed petal shape, apex, base, and margin descriptor.

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M. Page 3, line 4, Applicant should set forth in the specification additional information relative to the instant tree's pedicel including pedicel coloration with reference to the employed color chart.

N. Page 3, lines 6-8, Applicant should set forth in the specification additional information relative to the instant tree's flower bud including bud coloration with reference to the employed color chart.

O. Page 3, line 12, Applicant sets forth a petal color but has not stated whether the coloration is for the upper, lower, or both petal surfaces. Applicant should set forth in the specification a color designation(s) for the upper and lower petal surfaces with reference to the employed color chart.

P. Page 3, line 17, Applicant states fruit shape is "Usually flat". When compared to the photographic illustrations provided. It appears fruit shape is not "flat". Applicant should review fruit shape and set forth in the specification an accurate fruit shape.

Q. Page 4, line 1, Applicant states "Puffing". This is an unrecognized term. Correction and/or clarification is necessary.

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R. Page 4, line 9, Applicant states vesicles are “2-4 mm” but does not state whether this is a length, diameter, or other. Correction and/or clarification is necessary.

S. Page 4, line 17, Applicant states fruit is “Seedless under non-pollinating conditions”. It is uncertain whether the instant tree produces seeds at all. Applicant has not stated whether seeds are produced under pollinating conditions. Applicant should set forth in the specification meaningful information relative to the instant tree’s seed. If produced, Applicant should set forth information relative to seeds including the typical and observed number of seeds per fruit, shape, length, width, and coloration with reference to the employed color chart.

T. Applicant should provide a detailed botanical description for reproductive organs including stamens, anthers, stigma, styles, ovary/ies, pistil, (such as quantity, size and coloration of organs) and whether pollen is produced and pollen amount, i.e. scarce, moderate, abundant, and coloration (if produced) into the specification with reference to the employed color chart.

Applicant should provide some meaningful information relative to the instant tree’s reproductive organs, maybe not in the depth as set forth in the above paragraph but should provide at least some meaningful information.

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U. Applicant should set forth in the specification information relative to the instant tree's fruit albedo including the typical and observed thickness and coloration with reference to the employed color chart.

V. Applicant should set forth in the specification additional information relative to the instant tree's fruit flesh including flesh color with reference to the employed color chart.

W. Applicant should set forth in the specification the typical and observed amount of fruit produced per season per tree.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

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**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Claim Rejection - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The Claim is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application number 20001110 (European Union) taken in view of the article by Bono et al. ('Clemenpons' and 'Loretina', Two Early Clementine Mandarin Mutations of Potential Interest, 174-176, 1996) and in further view of the article by Perez (Resultados Sobre La Desverdizacion En Nuevas Variedades: Clemenpons Y Loretina, 117-124, Jun-Jul 1997).

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The cultivar ‘Clemenpons’ is described in Plant Breeder’s Right application 20001110 filed in The European Community on July 4, 2000 and published on October 16, 2000, more than one year prior to the filing of the instant application. This application was granted August 6, 2001 having grant number 7987. The published European Community application is a “printed publication” under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the European application, 20001110, are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the information in this register is published every two months.

Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publication standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show the primary reference has an “enabled disclosure”. *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference,

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combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”). See also MPEP § 2121.03.

The Bono et al. article discloses that ‘Clemenpons’ was available in at least May 1996 (entire article), five and a half years prior to the filing date of the instant application in the United States. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application’s United States filing date.

The Perez article discloses that ‘Clemenpons’ was available in at least Jun-Jul 1997, four and a half years prior to the filing date of the instant application in the United States. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application’s United States filing date.

Thus with the availability of the instant cultivar, the published European Community Breeder’s Right application is enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to

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do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thompson, supra*. See also Copper, Biotechnology and the Law § 8.05 (1998 Clark Boardman Callaghan). “In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.”

**Comments**

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicant should note the new amendment format which is permitted now but will become mandatory this summer (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL  
PRIMARY EXAMINER

*Kent L. Bell*